

## **REMARKS**

Claims 1-9 and 13-16 are now pending in the application. Minor amendments have been made to claims to simply overcome the objections and rejections of the claims under 35 U.S.C. § 112. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1-9 and 13-16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicants regard as the invention. The Examiner's attention is directed to claims 1 and 16, which have been amended to overcome the examiner's rejection.

### **REJECTIONS UNDER 35 U.S.C. §102 &. § 103**

Claim 16 stands rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Smith (EPO 1 030 069). Claims 1 and 3 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Smith (EPO 1 030 069). Claims 2, 4-9 and 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to Claim 1 above, and further in view of Lacey (U.S. Patent No. 4,958,971). Claims 1-9 and 13-16 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey (U.S. Patent No. 4,958,971) in view of Gossman (U.S. Patent No. 5,496,140). In view of the amendments and arguments herein, these rejections are respectfully traversed.

The Examiner's attention is directed to independent Claim 16 which has been amended to include the limitation that the radial indentations have a thickness between about 15 to about 30% of the shell thickness. Applicants note that the Smith reference (EPO 1 030 069) is completely silent as to this limitation. As such, Applicants submit that the rejection under 35 U.S.C. § 102 has been overcome.

The Examiner's attention is further directed to independent Claims 1 and 16 which are product-by-process claims. In this regard, each of the claims and their dependents include the limitation that the radial indentations are "crimped" into the rivet shell. MPEP § 2113 states the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. Page 5 of the Office Action states, "In response, the Applicant is reminded that in article claims, the process by which a product is made is of no consequence; all that is considered for patentability is the final product." The Office Action further states, "With this in mind each of the "crimped", "rolled" and "embossed" are all terms meaning the sleeve is plastically deformed by compressing the material to form the indentation thus would all provide a localized hardening resulting in the same final product." Applicants respectfully traverses this characterization.

While Applicants admit that all of these formation techniques would lead to the plastic deformation of the shell material, it is Applicants' assertion that these techniques would not form "the same final product." In this regard, Applicants note that when

utilizing the “roll form” formation technique as shown in Smith, the plastic deformation of the rivet would tend to also cause plastic deformation of the shell leaving an elliptically formed shell body. This is opposed to the rivet formed by crimping. The Applicants are prepared to submit an Affidavit in this regard if necessary.

The Office Action further states that “embossed” is simply a broad term encompassing both “rolled” and “crimped” where “rolled” and “crimped” are well known different modes of manufacturing which again, are of no consequence in the resultant final product. While Applicants agree that the term “embossed” may cover many known modes of manufacture, Applicants disagree with the contention that the term “embossed” means and specifically defines “crimped.” Further, the Applicants respectfully traverse the characterization that the different modes of manufacture are of “no consequence” in the resultant final product. In this regard, Applicants direct the Examiner’s attention to independent Claim 1 which includes the limitation that the hardness of the rivet shell in the region of the indentations is between 20 and 30% higher than the hardness of the rivet shell at a point midway between adjacent longitudinal space indentations. It is respectfully submitted that none of the references disclose this limitation. Furthermore, Applicants respectfully submit that changes in the hardness of material due to cold working is a function of the material properties of the base metal as well as the deformation seen by the material and is, therefore, not inherent in the cited prior art.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed

rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

With respect to Claim 16, Applicants submit that none of the references teach specific thicknesses of the material of the indentation. Applicants, therefore, assert that the requisite burden needed to establish a prima facie case of obviousness has not been met.


## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the

Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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